

REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

Claims 1, 10 and 11 have been amended to correct inadvertent typographical error without adding any new matter. Accordingly, claims 1-11 are presented for consideration.

Claims 1-11 have been rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,903,632 (Brandon) in view of U.S. Patent No. 5,684,868 (Alexander). Applicant respectfully traverses this rejection.

Brandon is directed to "a computerized telephone directory system for identifying and displaying directory information related to incoming and outgoing telephone calls." (col. 1, lines 7-10) However, contrary to the Examiner's assertion, Brandon does not teach or suggest a memorization or indication device that is operable to "memorize or indicate the data as a function of the line state signal of the telephone line," as called for in amended claim 1 and similarly in claims 10 and 11. In fact, col. 2, lines 58-62 of Brandon, cited by the Examiner, merely describes that "a line monitor 23 informs the CPU 13 that the telephone line is in use by another extension and whether the call originated as an incoming or an outgoing call." The line monitor 23 informs the CPU 13 so that when an incoming call is received, the CPU 13 can signal

"the display driver 42 to turn the display screen 3 pink to give a visual indication to anyone proximate to or remote from the screen 3 that a call is being received. Moreover, if an outgoing call, placed on an extension, is in progress, the line monitor 23 signals the CPU 13, which instructs the display driver 42 to turn the display screen blue. This gives a visual indication that the line is in use." (col. 7, lines 37-45)

That is, Brandon utilizes the memorization means to automatically realize a telephone directory for use in combination with a telephone. (see col. 1, lines 50-51) The memorization of the telephone numbers is activated when an incoming or an outgoing telephone call is performed on the telephone (see col. 2, lines 1-5), but Brandon does not teach or suggest providing a line state signal to the memorization means, as called for in claims 1, 10 and 11.

Moreover, Brandon does not teach or suggest a telephone wherein the line monitor 23 is connected to the memorization or indication means.

Further, as admitted by the Examiner, Brandon fails to teach or suggest “a detector for outputting a line state signal of the telephone line to the memorization device.” (office action, page 2, paragraph 2) To cure this deficiency, the Examiner turns to Alexander.

Alexander is directed to a communication line monitoring system for determining “blocked calls to a communication terminal.” (col. 1, lines 12-13) That is, the line monitoring device of Alexander is connected in parallel to a plurality of telephones through a plurality of telephone lines. (see Fig. 1; col. 4, lines 36-38) However, contrary to the Examiner’s assertion, Alexander does not teach or suggest a telephone comprising a memorization or indication device that is operable to “memorize or indicate the data as a function of the line state signal of the telephone line,” as called for in amended claim 1 and similarly in claims 10 and 11. In other words, Alexander fails to teach or suggest memorization or indication of data on telephone calls when several telephones are connected to a single telephone line. Accordingly, the addition of Alexander does not cure the aforementioned deficiencies of Brandon.

Accordingly, it is respectfully submitted that when one combines Brandon with Alexander, the results of such a combination still does not meet the terms of claims 1, 10 and 11 because neither reference teaches or suggests a telephone comprising a memorization or indication device that is operable to “memorize or indicate the data as a function of the line state signal of the telephone line.”

In view of the foregoing differences, it is respectfully submitted that the combination of Brandon and Alexander does not render obvious claims 1, 10 and 11.

Further, there is no motivation in Brandon or in Alexander to suggest that the teachings of these two references should be combined. In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Fritch, (Fed. Cir. 1992) 91-1318; In re Laskowski, 10 U.S.P.Q. 2d 1397, 1299 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (1987) is quite relevant. There, the Federal Circuit stated:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

* * *

“At best in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these known [agents]. However, this is not the standard of 35 U.S.C. Section 103.”

Moreover, absent applicants' disclosure, there appears to be absolutely no reason to add Alexander to Brandon so as to provide a memorization or indication device for accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line, especially since these two references are concerned with completely different problems. In fact, the only reason one might turn to Alexander, if at all, is because of the hindsight gleaned from applicant's own disclosure. The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Redkin-Wiley, 5 U.S.P.Q. 2d, 1434, 1438 (Fed. Cir. 1988):

“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.”

* * *

“...it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In Uniroyal, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Company, 221 U.S.P.Q. at 489, to conclude that “the mere fact that a device or process utilizes a known scientific principal does not alone make that device or process obvious.” 5 U.S.P.Q. 2d at 1440.

In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

“The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.”

In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference “upside down,” the CAFC ruled:

“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Brandon, would not even turn to Alexander – and if he did, he would not understand how or why Alexander’s communication line monitoring system should be combined with Brandon’s automated telephone directory.

Furthermore, the claimed invention defined by apparatus claims 1, 10 and 11 eliminates the shortcomings and disadvantages encountered with the prior art. Specifically, the claimed invention allows a telephone to accurately memorize and indicate data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line. It is undeniable that neither Brandon nor Alexander is even remotely concerned with the problem associated with the accurately memorizing and indicating data relating to

incoming and/or outgoing calls when several telephones are connected to a single telephone line. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Brandon or Alexander, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988). There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". Id. at 1962. See also, In re Rinehart, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem associated with the accurately memorizing and indicating data relating to incoming and/or outgoing calls when several telephones are connected to a single telephone line was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in Ex parte Breidt and Lefevre, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in Ex parte Minks, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection". Id. at 121.

In view of the foregoing authorities, it is submitted that, since neither Brandon nor Alexander is even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claims 1, 10 and 11, these claims are unobvious and patentably distinct over the combination of Brandon and Alexander. The allowance of claims 1, 10 and 11 is solicited for the reasons given above.

Since claims 2-9 depend from claim 1, the foregoing discussion of claim 1 is equally applicable to claims 2-9 and the allowance of claims 2-9 is respectfully solicited for the reasons given above with respect to claims 1, 10 and 11.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the applicant's undersigned attorney and, in the event that

the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Applicant's representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Brandon and Alexander.


Accordingly, it is respectfully maintained that all rejections and objections have been overcome, and that the present application is now in condition for formal allowance.

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Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-GRYN 204 (10109100) from which the undersigned is authorized to draw.

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Respectfully submitted,

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